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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,252	09/24/2003	Hitoshi Endo	OKI.571	4296
20987	7590	01/25/2005	EXAMINER	
VOLENTINE FRANCOS, & WHITT PLLC ONE FREEDOM SQUARE 11951 FREEDOM DRIVE SUITE 1260 RESTON, VA 20190			LAU, TUNG S	
			ART UNIT	PAPER NUMBER
			2863	

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,252

Applicant(s)

ENDO ET AL.

Examiner

Tung S Lau

Art Unit

2863

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-9, 13, 11 and 14 is/are rejected.
- 7) ☒ Claim(s) 3 and 10, 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 5, 7, 8, 9 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Osawa et al. (U.S. Patent 5,946,247).

Regarding claim 1:

Osawa discloses a test method of a memory IC function, comprising the following steps of preparing a memory tester (Col. 5, Lines 18-55); preparing memory ICs of different types (Col. 40-41, Lines 48-39); transmitting data related to each test method of these memory the memory tester (Col. 40-41, Lines 48-39); generating a random number (Col. 40-41, Lines 48-39); executing a test of a predetermined memory IC in reply to the generated random number (Col. 40-41, Lines 48-39); and judging whether the tests of the memory ICs are finished or not: repeating the generation of the random number and the execution of the test when they are not finished; and finishing the processing when they are finished (Col. 8, Lines 48-56).

Regarding claim 7:

Osawa discloses a test method of a memory IC function, comprising the

following steps of: preparing a memory tester (Col. 5, Lines 18-55); preparing ICs of different types (Col. 40-41, Lines 48-39); related to each test method of these transmitting data ICs to the memory tester (Col. 40-41, Lines 48-39); generating a random number (Col. 40-41, Lines 48-39); executing a test of a predetermined IC in generated random number (Col. 40-41, Lines 48-39); and reply to the judging whether the tests of the are finished or not: repeating the generation of the random number and the execution of the test when they are not finished; and finishing the processing when they are finished (Col. 8, Lines 48-56).

Regarding claims 2, 8, Osawa discloses random number is arbitrary from 0 to 255 (Col. 2, Lines 25-53, Col. 40-41, Lines 48-39); Regarding claims 4, 13, Osawa discloses timer interruption processing of the IC (Col. 42-43, Lines 18-43); Regarding claim 5, Osawa discloses processing with a predetermined cycle (Col. 42-43, Lines 18-43); Regarding claim 9, Osawa discloses memory IC (Col. 40-41, Lines 48-38), communication interface (Col. 40-41, Lines 48-38) and CPU (fig. 92, unit 331);

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

a. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Osawa et al. (U.S. Patent 5,946,247) in view of Eric Knorr, The PC Bible, 2nd edition, 1995, page 166-167.

Osawa discloses a method including the subject matter discussed above except exclusively discloses the cycle define by milliseconds. Eric Knorr discloses the cycle define by milliseconds (page 167, section 'match clock speed), in order for the computer to run properly (page 167, section 'match clock speed). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Osawa to have the cycle define by milliseconds taught by Eric Knorr in order for the computer to run properly (page 167, section 'match clock speed).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112 that form the basis for the rejections under this section made in this Office action:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 11 is rejected under second paragraph of 35 U.S.C. 112. The claims contain the trademark/trade name USB. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982).

The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe communication standard and, accordingly, the identification/description is indefinite

Claim Objections

4. Claims 3, 10 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitation of the base claim and any intervening claims.


The following is an examiner's statement of reasons for allowance: prior art fail to teach: regarding claims 3 and 10, the memory including Flash Rom, Dram and Sdram; regarding claim 12, the CPU IC including DMAC.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Art Unit: 2863

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tung S Lau whose telephone number is 571-272-2274. The examiner can normally be reached on M-F 9-5:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on 571-272-2269. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TL


John Barlow
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